

Application Serial No.: 09/893,460

Attorney Docket No. 089070-0311366 (23449-013)

In Response to Office Action mailed March 25, 2005

**AMENDMENTS TO THE DRAWINGS:**

- The nine (9) attached sheets of drawings in **APPENDIX A** replace the sheets depicting FIGS. 9, 12-18, and 23 that were filed with the substitute drawings submitted on October 23, 2001.
- The nine (9) attached sheets of drawings in **APPENDIX B** are marked-up versions of the replacement sheets provided in **APPENDIX A**. These sheets are provided to highlight the corrections made in the replacement sheets provided in **APPENDIX A**.
- The changes made to FIGS. 9, 12-18, and 23 are described in the **Remarks/Arguments** section beginning on page **11** of this paper.

**APPENDIX A:** Replacement Sheets for FIGS. 9, 12-18, and 23.

**APPENDIX B:** Marked-up Versions of the Replacement Sheets for FIGS. 9, 12-18, and 23.

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### **REMARKS**

In response to the Office Action mailed March 25, 2005 (hereinafter "Office Action"), claims 3, 17, 20, 28, 39, and 40 have been amended. No claims have been cancelled or newly added. Therefore, claims 1-40 remain pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

### **INFORMATION DISCLOSURE STATEMENT (I.D.S.)**

Applicant thanks the Examiner for considering the references cited in both the electronic I.D.S. and paper I.D.S. filed February 13, 2002, as evidenced by the signed and initialed copies of the PTO-1449 Forms returned with the First Office Action.

Applicant is submitting herewith a Supplemental Information Disclosure Statement and respectfully requests that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

### **SPECIFICATION**

The Specification has been amended to update related application data.

### **DRAWINGS**

Applicant previously submitted a set of substitute drawings on October 23, 2001. Subsequently, it was discovered that there were inadvertent errors and omissions in the

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substitute drawings submitted for FIGS. 9, 12-18, and 23. As such, to ensure that these figures match the figures that were originally filed with the Specification, Applicant is submitting herewith nine (9) attached sheets of drawings in APPENDIX A that replace the sheets depicting FIGS. 9, 12-18, and 23 previously filed with the substitute drawings submitted on October 23, 2001.

The nine (9) attached sheets of drawings in APPENDIX B are marked-up versions of the replacement sheets provided in APPENDIX A. These sheets are provided to highlight the corrections made in the replacement sheets provided in APPENDIX A.

Applicant submits that the changes to the drawing figures described above do not constitute the addition of new matter, as support for the instant corrections is provided throughout the as-filed Specification and the drawing figures as originally filed. Accordingly, Applicant requests that the Examiner approve the changes to the drawing figures.

#### NON-STATUTORY DOUBLE PATENTING REJECTION

Claim 1 stands rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claim 43 of U.S. Patent Application No. 10/119,082 to Gatto (hereinafter "Gatto '082). See Office Action, pg. 3, ¶5. In particular, the Examiner alleges that all of the features of independent claim 1 of the above-referenced application are listed in claim 43 of Gatto '082, with the exception of "*means for issuing an alert when at least one predetermined alert condition has been satisfied.*" The Examiner alleges that this feature would have been obvious to one of ordinary skill in the art, however, because the "*issuance of alert would have allowed the user to take appropriate action in response to the alert.*" Applicant traverses this rejection.

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Claim 1 of the above-referenced application includes the feature of “*means for analyzing the current estimate data and determining when one or more alert conditions are satisfied.*” The Examiner alleges that this feature is present in claim 43 of Gatto ‘082. Specifically, the Examiner alleges that the “*at least one error metric*” as recited in claim 43 is an alert condition. This is incorrect.

Claim 43 of Gatto ‘082 is directed to a computer-implemented system for objectively measuring security analysts’ performance based on historical accuracy of their earnings predictions for one or more securities. The claim recites a user interface for selecting criteria, and a processor for determining performance based on the selected criteria and historical data. One example of the criteria that may be selected includes at least one error metric to be used to calculate performance. As such, in claim 43 of Gatto ‘082, error metrics are not alert conditions relating to current estimate data for a plurality of analysts. By contrast, the error metrics may comprise various metrics used when objectively measuring security analysts’ performance based on historical accuracy of their earnings predictions for one or more securities. As such, this rejection is improper for *at least* the reason that it appears to be predicated on a misinterpretation of the term “error metric” as it used in claim 43 of Gatto ‘082.

Moreover, the Examiner’s recited motivation for modifying Gatto ‘082, as quoted above, is legally improper for *at least* the reason that it only states what a benefit of the modification would be, but fails to demonstrate any teaching, suggestion, or motivation found in either Gatto ‘082, or in the knowledge generally available to one of ordinary skill in the art, as to why it would have been obvious to modify Gatto ‘082.

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For *at least* each of the foregoing reasons, this rejection is improper and should be withdrawn.

#### **REJECTIONS UNDER 35 U.S.C. §101**

Claim 40 stands rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. *See* Office Action, pgs. 2, ¶s 2-3. Although Applicant disagrees with the rejection of the Examiner and contends that the Examiner is improperly reading limitations into 35 U.S.C. §101 on the subject matter that may be patented, Applicant has amended claim 40 to include the Examiner's suggested claim language. Accordingly, withdrawal of this rejection is earnestly sought.

#### **ALLOWABLE SUBJECT MATTER**

Applicant thanks the Examiner for the indication of allowable subject matter. The Examiner has indicated that claims 4 and 5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. *See* Office Action, pg. 6, ¶8.

#### **REJECTIONS UNDER 35 U.S.C. §103**

The Examiner has rejected claims 1-3 and 6-40 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,608,620 to Lundgren in view of U.S. Patent No. 6,208,720 to Curtis *et al.* ("Curtis"). *See* Office Action, pg. 4, ¶7. Applicant traverses this rejection for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

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A. Independent Claims 1 and 40.

In the Office Action, at pg. 5, the Examiner recites that Lundgren does not explicitly teach the features (in independent claims 1 and 40) of determining when one or more alert conditions are satisfied, and issuing an alert when at least one predetermined alert condition is satisfied for at least one analyst, as disclosed and claimed by Applicant. The Examiner relies on Curtis for these features, however, alleging that the “*combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions.*”

The Examiner’s recited motivation merely states what the alleged combination of the disclosures would suggest, or what “benefit” the combination of the disclosures may provide. In other words, the Examiner has focused on the “result” of the combination of Lundgren and Curtis, but has not provided a legally proper teaching, suggestion, or motivation to combine the two references. This is legally improper. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

Having provided no motivation to combine or modify the references, other than to state what a benefit of the combination may be, it appears as though the Examiner has engaged in hindsight reconstruction to pick and choose among separate disclosures to allegedly arrive at Applicant’s claimed invention. For *at least* this reason, the Examiner has failed to establish a *prima facie* case of obviousness and, accordingly, the rejection of claims

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1 and 40 is improper and should be withdrawn. Dependent claims 2-3 and 6-39 are allowable because they depend from allowable independent claim 1, as well as for the further limitations they contain.

B. Dependent claims 2-3, and 6-39.

Applicant traverses the Examiner's unsupported contention (*see* Office Action, pg. 5) that the features of claims 2-3, and 6-39 are old and well known in the art. The Examiner alleges that it would have been obvious to include the features of claims 2-3, and 6-39 with the combined disclosures of Lundgren and Curtis because the *"combination of the disclosures taken as a whole suggests that users would have benefited from being informed about abnormal conditions so as to take appropriate actions in response to the notification of abnormal conditions."*

Aside from providing a motivation identical to that alleged in the rejection of claims 1 and 40 (as discussed above), the Examiner has provided no evidence to support the contention that the features of any of claims 2-3 and 6-39 are old and well known in the context of a system for monitoring analysts' estimates, as disclosed and claimed by Applicant.

Accordingly, having provided no evidentiary support for the rejection of any of dependent claims 2-3 and 6-39, the Examiner's rejection of these claims is improper and should be withdrawn.

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**CONCLUSION**

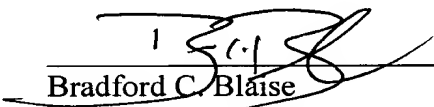
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: June 27, 2005

Respectfully submitted,

By:

  
Bradford C. Blaise

Registration No. 47,429

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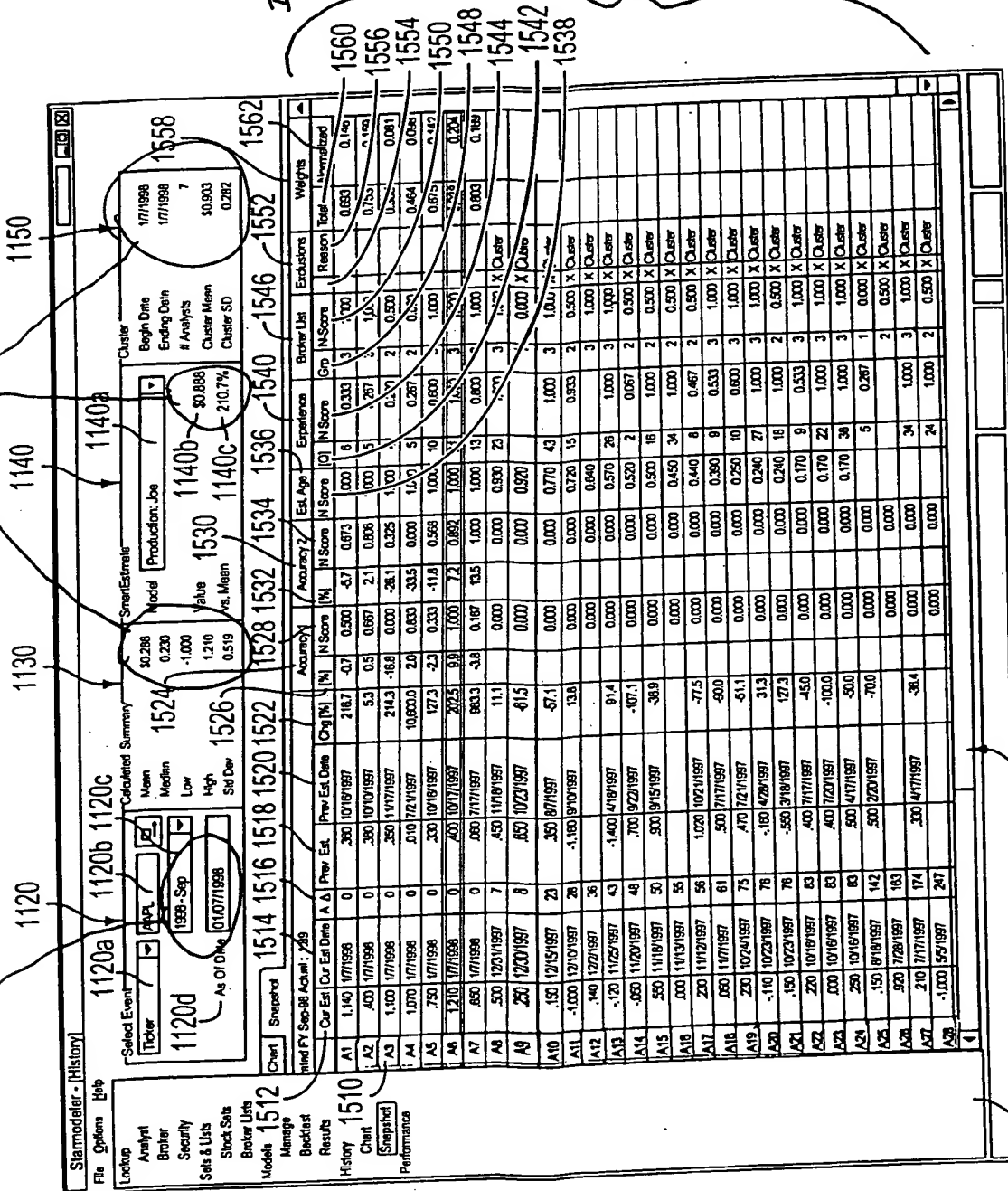




INFORMATION  
AMENDED

DATE AMENDED

Information included in FIG. 12 as originally filed, but not included in previously submitted Formal Drawing for FIG. 12.



1115

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CAPTION AMENDED

2110 2120

StarModeler

File Options Help

Lookup Analyst Broker Security Sells & Lists Stock Sets Broker Lists Models Manage Backfast Results History Chart Snapshot Performance

Name Copy Save Move Delete Job 2170 2174 2178 2182 2180 2176

General Accuracy 1 Accuracy 2 All Star Broker List Experience Estimate Age

Model Name Joe

Exclusions

☒ Exclude estimates older than 100 days old.

☐ Exclude estimates more than 2.5 standard deviations from the mean.

☒ Attempt to delete most recent cluster. Exclude all estimates prior to this point.

Cluster Definition

Adjacent estimates have a difference of 70 or more than 3 days.

Estimates are revised in same direction by at least 5 percent

☐ Fixed number of analysts: at least 4 analysts

☐ Variable number of analysts

Require 2 analysts when # of analysts is between 2 and 4

Require 3 analysts when # of analysts is between 5 and 6

Require 4 analysts when # of analysts is between 8 and 10

Require 20% of analysts when followed by 21 or more analysts.

Factor Weights

Accuracy 1: 40(19.51%)

Accuracy 2: 60(29.27%)

All Star: 0(0.00%)

Broker List: 35(17.07%)

Experience: 35(17.07%)

Estimate Age: 35(17.07%)

2150

2130

2140

2160

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Information Amended

Information added or amended.

Information included and amended.

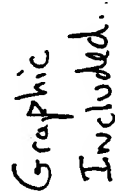
Graphic included

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FIG. 13

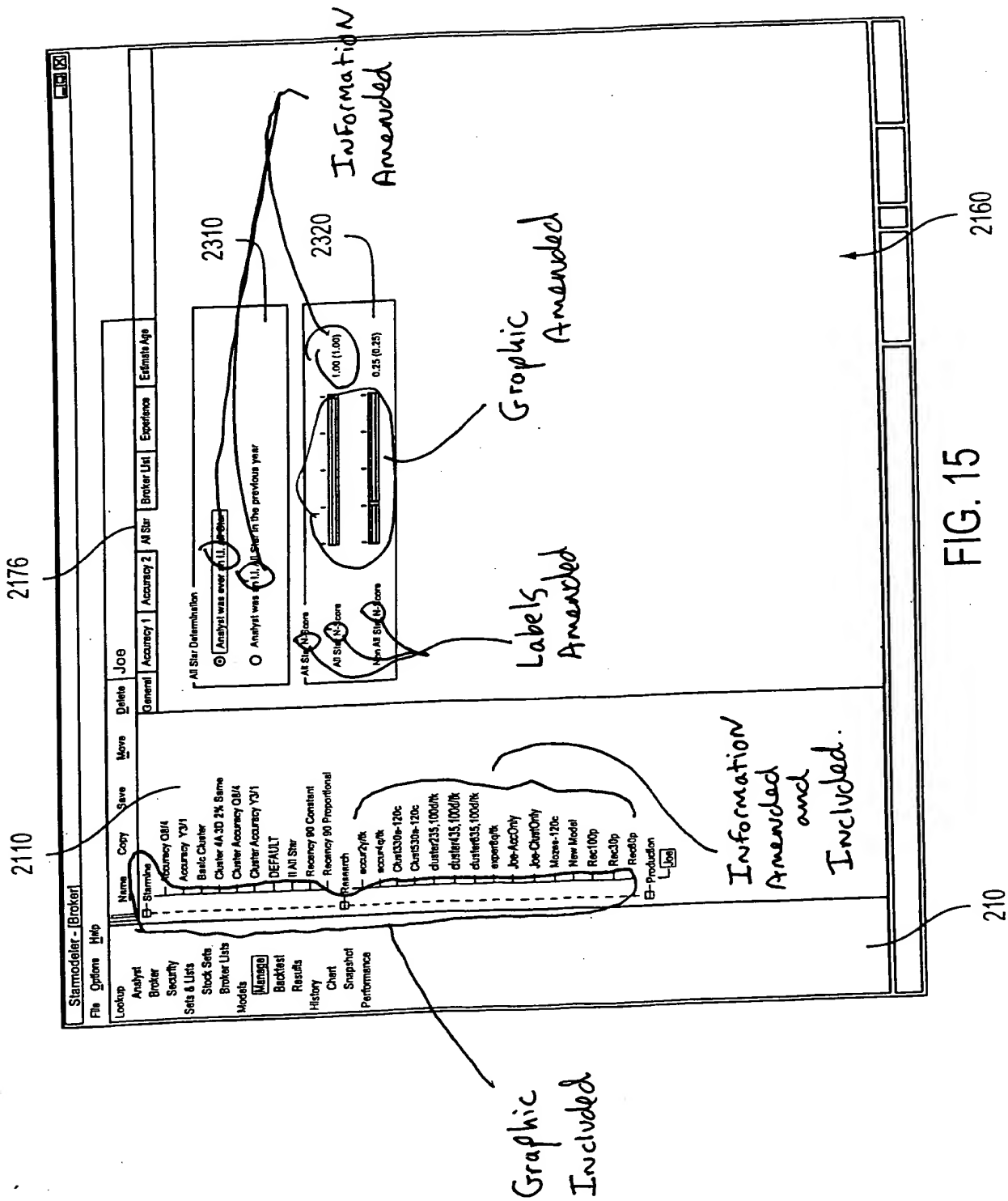
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Information  
Amended

Information  
included  
or  
Amended

FIG. 14 2160



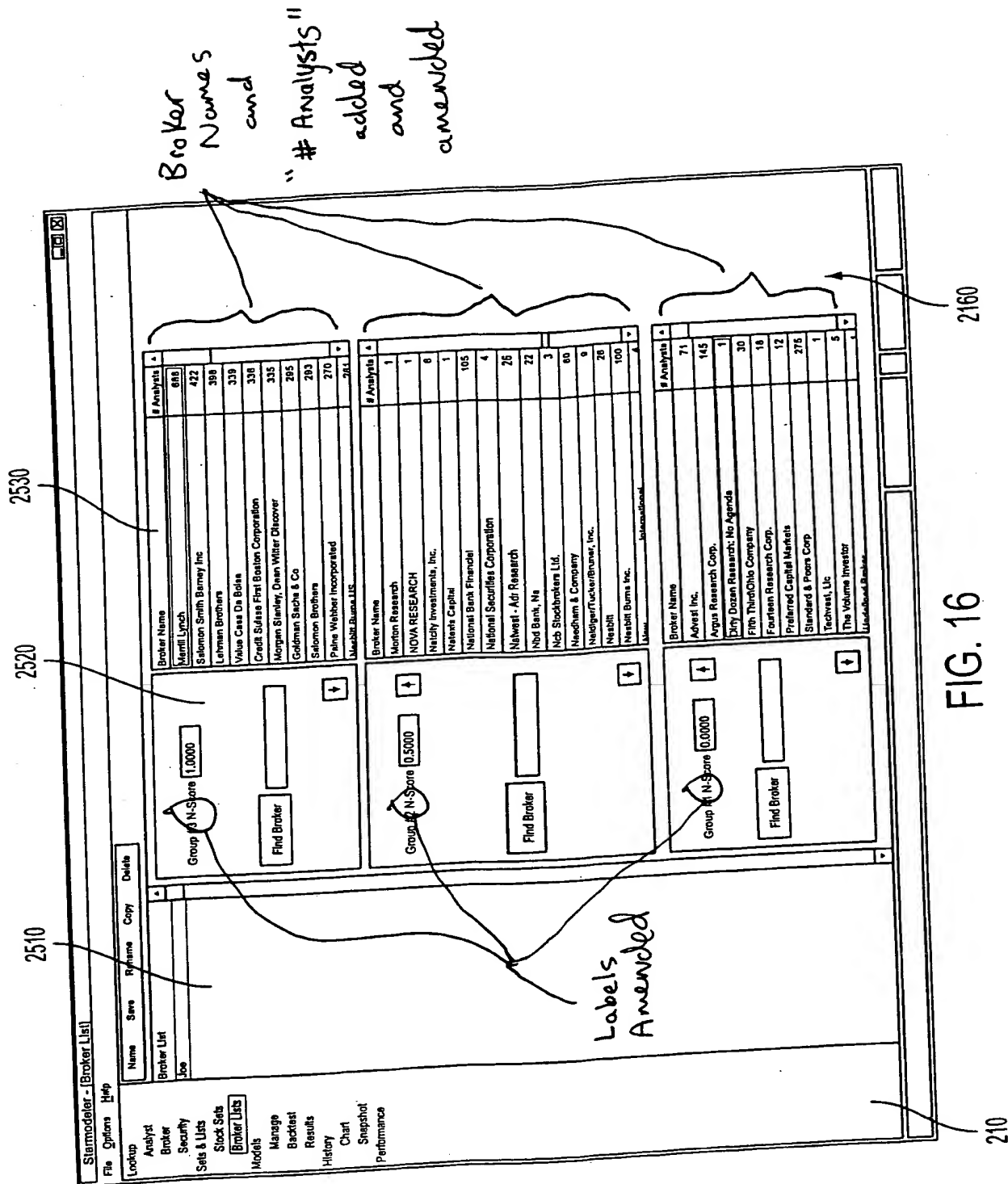


FIG. 16

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CAPTION  
AMEND

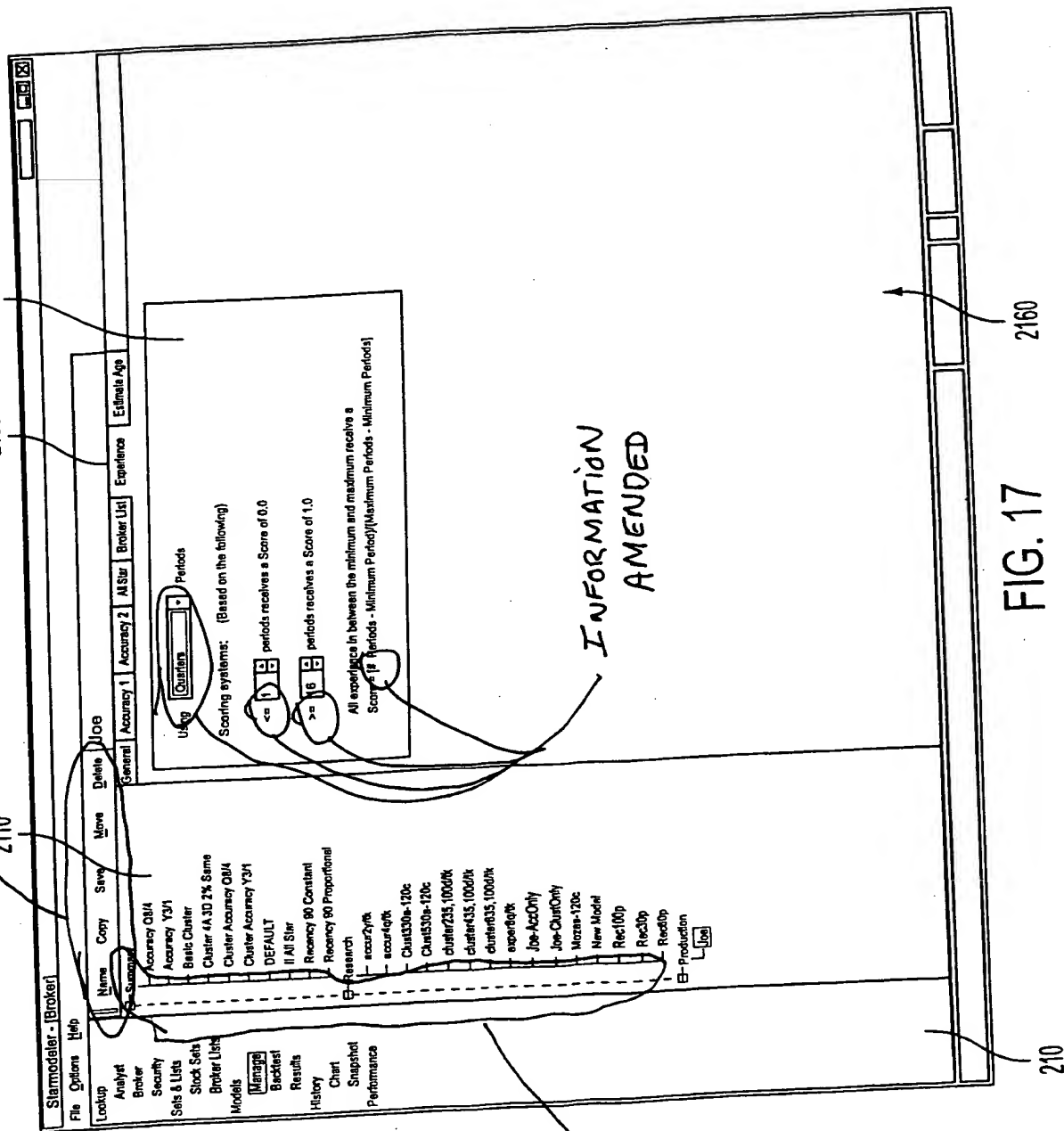


FIG. 17

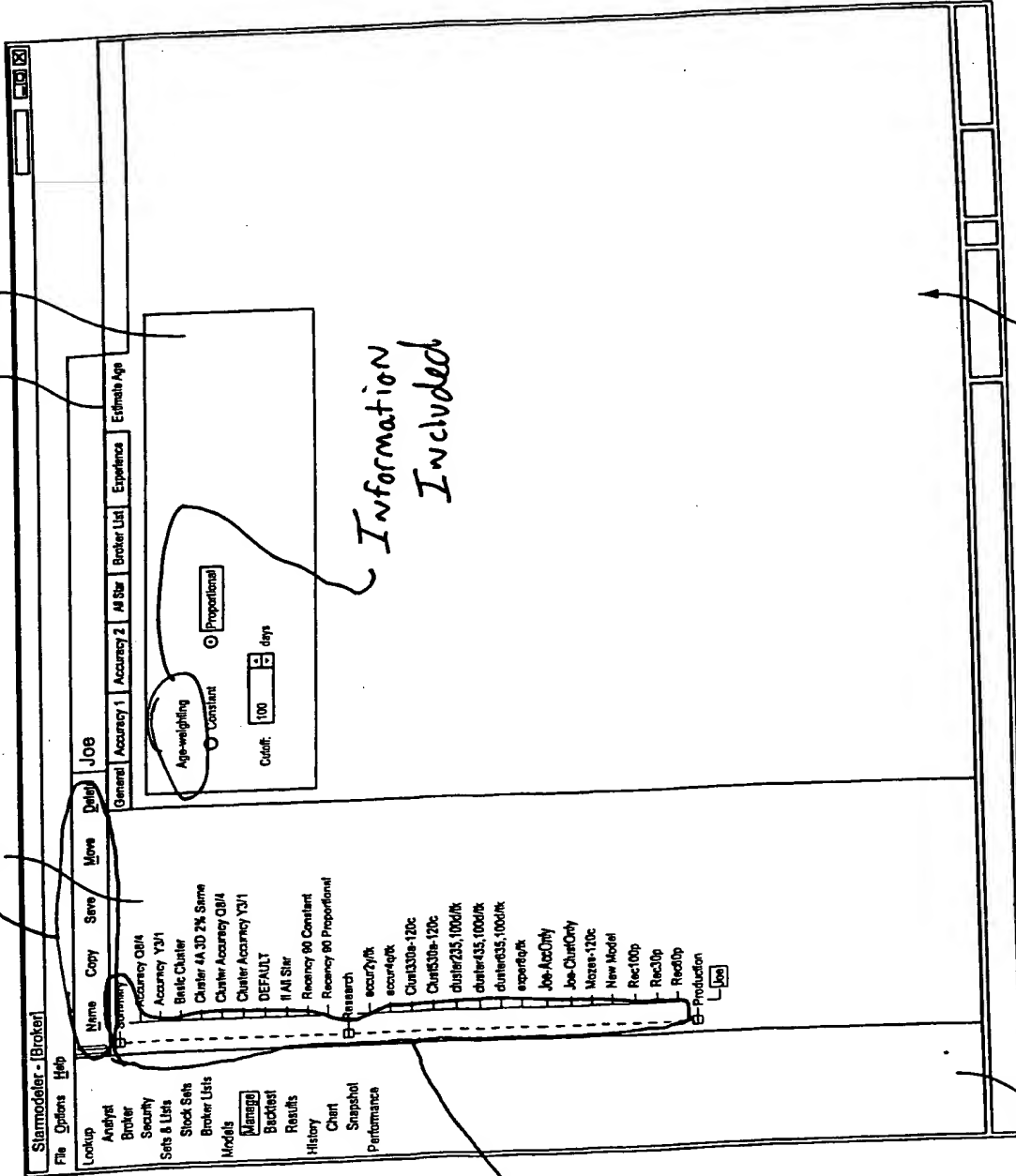
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2160

CAPTION  
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2132 2710

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Information  
Included

Graphic  
Included

FIG. 18

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Information Amended.

DATES AMENDED

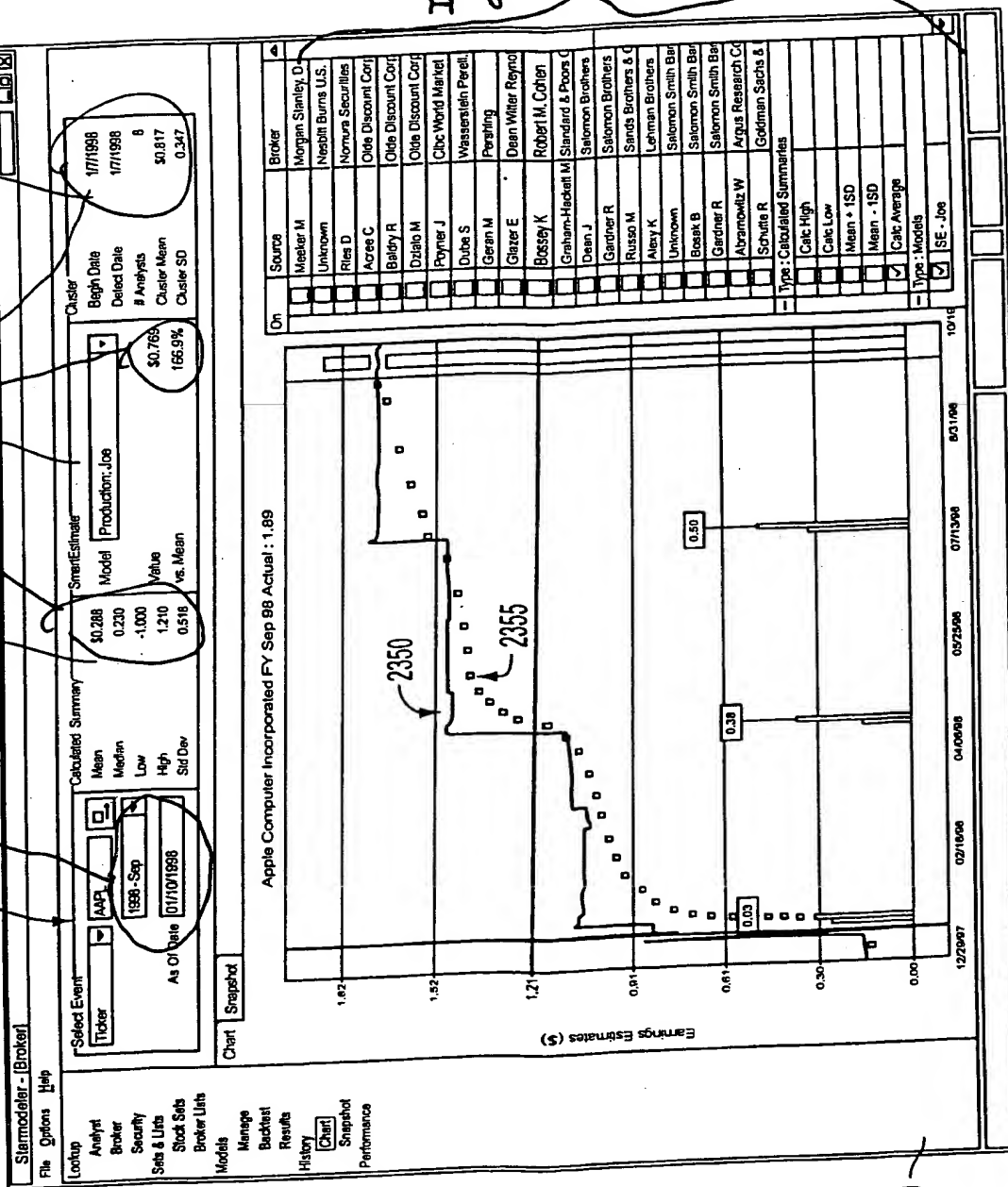
Info. added and amend

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FIG. 23